REMARKS

The Applicant respectfully requests reconsideration of the application in view of the foregoing amendments and following remarks.

Claims 1-45 are currently pending.

In the final Office action mailed September 30, 2004 ["final Office action"], claims 1-15 and 19 were rejected as being unpatentable under 35 USC § 102(b) in view of description of various systems in the Background of the present application. [Final Office action, page 4.] As detailed below, the Applicant respectfully disagrees with the rejections of claims 1-15 and 19.

Claims 20-45 have been allowed and claims 16-18 have been objected to as being dependent on a rejected base claim but otherwise allowable.

The Examiner has imposed a restriction requirement and withdrawn claims 46-60 from consideration. The Applicant respectfully disagrees with the reasoning behind the restriction requirement. The Applicant has canceled claims 46-60 without prejudice to renewal, however, so as to expedite prosecution of the present application.

I.   Initialed Form 1449's

Please provide the following initialed Form 1449s:

(1) Page 1 (of 2) of the Form 1449 for the IDS filed February 16, 1999 (received by the US PTO on February 22, 1999), which lists among other things U.S. Patent No. 3,427,443.

(2) Page 1 (of 1) of the Form 1449 for the IDS filed January 10, 2000 (received by the US PTO on January 18, 2000), which lists among other things two non-patent references by Aral et al.

(3) Page 1 (of 1) of the Form 1449 for the IDS filed January 19, 2000 (received by the US PTO on February 1, 2000), which lists among other things non-patent references by Keppel and Larus et al.

(4) Page 1 (of 1) of the Form 1449 for the IDS filed April 1, 2004 (received by the US PTO on April 5, 2004), which lists among other things non-patent references by Hamlin and Kimelman et al.

II.   The Examiner's Use of the Background as Prior Art Under § 102 Is Incorrect

In rejecting claims 1-15 and 19 under § 102(b), the Examiner has incorrectly combined features from separate systems (each described in the Background of the present application) into a single reference labeled "AAPA." Specifically, the Examiner has cited parts of the Background

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about two different distributed object systems (COM and CORBA) and three different ADPS systems (ICOPS, CAGES, and IDAP). [Office action dated October 29, 2003, pages 6-7.] The Examiner writes in the final Office action:

> AAPA stands for applicant's admitted prior art, which is used as a single reference for the well-known prior art concept provided by the applicant. Rejected claims under AAPA are not limited to any one single system, hence the well-known concept admitted by the applicant in the disclosure, i.e., AAPA, is used as a single primary reference for the rejection of the claims.

[Final Office action, page 4.] The Applicant disagrees with the Examiner's application of the relevant law. The Applicant also disagrees with the Examiner's characterization of the Background.

Except under a few circumstances that do not apply here, a § 102(b) rejection must be based upon a single prior art reference. [MPEP 2131.] The Background of the present application is not itself a single prior art reference under § 102(b) or any other section of § 102. Further, the Applicant has never admitted, suggested, "provided" or otherwise taken the position that the separate systems described in the Background collectively form a "well-known prior art concept" to be used as a single primary reference against the claims, as the Examiner suggests. On the contrary, DCOM and CORBA are presented in the Background as different distributed object systems from different groups. [Application, page 2.] ICOPS, CAGES, and IDAP are presented in the Background as different ADPS systems from different groups. [Application, pages 4-5.]

The MPEP discusses admissions as prior art. For example, the MPEP states, "A statement by an applicant during prosecution identifying the work of another as 'prior art' is an admission that that work is available as prior art against the claims." [MPEP 2129.] The Applicant agrees that various systems and technologies identified in the Background are available prior art. In other words, the Examiner may correctly cite the Background to show: (1) the availability of certain DCOM prior art; (2) the availability of certain CORBA prior art; (3) the availability of certain ICOPS prior art; (4) the availability of certain CAGES prior art; and (5) the availability of certain IDAP prior art.

The MPEP also states, "Where the specification identifies work done by another as 'prior art,' the subject matter so identified is treated as admitted prior art." [Id.] The Applicant agrees that subject matter identified in the Background as prior art may be treated by the Examiner as admitted prior art. In other words, the Examiner may correctly treat as prior art: (6) the DCOM subject matter described in the Background; (7) the CORBA subject matter described in the Background; (8) the

ICOPS subject matter described in the Background; (9) the CAGES subject matter described in the Background; and (10) the IDAP subject matter described in the Background.

The Examiner goes beyond the Applicant's statements in the Background, however, when the Examiner treats the entire Background (or different selected parts of the Background) as a single primary reference. The Applicant respectfully requests that the Examiner provide citations to statutes, regulations, sections of the MPEP, or case law supporting his AAPA analysis.

An abstract example may help illustrate this point. Suppose a patent application is directed to a software method with steps A, B, and C. Suppose the Background of the application discusses (1) a first prior art software system that has A, (2) a second, unrelated prior art software system that has B, and (3) a third, unrelated prior art software system that has C. The Applicant has not thereby admitted the existence of a well-known prior art concept or provided a single primary reference with A, B, and C. On the contrary, the Applicant has merely tried to explain the state of the prior art in a thorough fashion and perhaps illustrate a problem to be solved. Any rejection that combines features from the first, second, and third software systems should be under § 103, not § 102.

III.   Claims 1-15 and 19 Should Be Allowable.

As noted in the previous section, the Examiner's use of the Background to reject claims 1-15 and 19 under § 102(b) is incorrect. For this reason, Claims 1-15 and 19 should be allowable.

The Examiner did not reject claims 1-15 and 19 under 35 USC § 103 and has not provided a motivation to combine features from the different systems described in the Background of the present application. However, the Examiner has apparently combined features from the different systems to reject claim 1. The Applicant will address this putative § 103 rejection of claim 1.

Claim 1 recites "generating a structural metadata description of the application from the type file, wherein the structural metadata description comprises compiled interface-level type description" and "profiling the application using the structural metadata description."

ICOPS, CAGES, and IDAP, taken separately or in combination, do not teach or suggest the above-cited language of claim 1. The ICOPS system generates metadata by compiling application source code [*see* Application, pages 4-5], which leads directly away from generating a structural metadata description of the application from a type file, as recited in claim 1. The IDAP system includes software for generating an instrumented version of an application for profiling [*see* Application, pages 4-5], which leads away from first generating a structural metadata description of the application from a type file and then using the description in profiling the application, as recited

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in claim 1. The CAGES system does not support generating metadata from a type file or profiling with such generated metadata [*see* Application, page 4], and also leads away from the above-cited language of claim 1.

The Examiner may be modifying the ICOPS, IDAP, or CAGES system with some feature of DCOM, CORBA, or another technology to create a system with "generating a structural metadata description of the application from the type file." [*See* Office action dated October 29, 2003, page 7.] Such a modification would be improper, as it would change the principle of operation of the ICOPS, IDAP, or CAGES system. [*See* MPEP 2143.01.]

In view of the foregoing discussion regarding claim 1, the Applicant will not belabor the merits of the separate patentability of claims 2-15 and 19.

CONCLUSION

Claims 1-45 should be allowable. Such action is respectfully requested.

REQUEST FOR INTERVIEW

In view of the preceding amendments and remarks, the Applicant believes the application to be allowable. If any issues remain, however, the Examiner is formally requested to contact the undersigned attorney at (503) 226-7391 prior to issuance of the next communication in order to arrange a telephonic interview. This request is being submitted under MPEP § 713.01, which indicates that an interview may be arranged in advance by a written request.

Respectfully submitted,

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